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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED:

40

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No
08/950,542

Applicant(s)
Bachovchin

Examiner
David Lukton

Group Art Unit
1653



☒ Responsive to communication(s) filed on May 22, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 35-51 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- ☒ Claim(s) 35-51 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

- ☐ All ☒ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) _____
- received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- Interview Summary, PTO-413

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

The request filed on 5/22/00 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/950542 is acceptable and a CPA has been established. An action on the CPA follows.

*

Claims 35-51 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35, last line recites "the compound" in the singular. However, "compound" should be in the plural. One option would be to use the following:

...wherein each of the compounds inhibits DP-IV activity.

The same applies to claim 42.

*

Claims 35-51 are rejected under 35 U.S.C. §103 as being unpatentable over Bachovchin (*J. Biol. Chem.* **265**, 3738, 1990) or Bachovchin (USP 4,935,493) or Bachovchin (WO 89/03223) or Flentke (*Proc Natl Acad Sci* **88**, 1556, 1991).

The teachings of the references were indicated previously. Applicants have traversed by arguing that the claims require no more and no less than 95% enantiomeric excess, and

THIS PARTICULAR LIMITATION IS NOT ACCURATE

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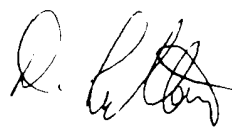
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The rejections are maintained.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.


DAVID LUKTON
PATENT EXAMINER
GROUP 1800